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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,197	08/31/2000	Ronald A. Modesto	00AB143	4226

7590 07/09/2002

Attention John J Horn
Rockwell Automation
Patent Dept / 704P Floor 8 T-29
1201 South Second Street
Milwaukee, WI 53204

EXAMINER	
LAU, TUNG S	

ART UNIT	PAPER NUMBER
2863	

DATE MAILED: 07/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/652,197	Applicant(s) MODESTO ET AL.	
	Examiner Tung S Lau	Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10-June 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-11,14-22 and 25-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-11,14-22 and 25-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims objections

1. Claim 14 is objected as the applicant cancel claim 13 which 14 is depends on. Correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Omum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of co-pending Application No. 09/652236. Claims 1-32 of co-pending application 09/652236 claims, for example only a press, measurement device and controller

with rail. Application No. 09/652236 contain the similar subject matter except the use of servo and guide, both of the applications talk about power to the system and a physical guide of the object, this obviously encompasses overlaps the instant claims. This is a provisional obviousness-type double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman, 11* F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970)-and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of

copending in view of Narushima et al. Claims 1, 4-11, 14-22 and 25-31 of co-pending application 09/652236 claim a press, measurement device and controller. Kuroyone teaches the use of a rail (col. 31, lines 11-20) and servo control (col.6, lines 1-26), Narushima teaches the use of an upper die sector(col.71-72, lines 64-24). It would have been obvious to modify the instant claims to have the rail, servo control and upper die taught by Kuroyone and Narushima in order to allow easy part manufacturing. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

a. Claims 1, 4-11, 14-22 and 25-31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kuroyone (US patent 5,464,424) in view of Takahashi et al. (US patent 5,299,351), Koseko et al. (U.S. Patent 5,603,871) and Narushima et al (U.S. Patent 6,341,516).

Kuroyone discloses a measurement system: Press die machine, sensors to measures die (col. 12-13, lines 65-50), press controller (col. 13, lines 66), punch

press type (col. 3, lines 4-13), sensor reading angle (fig. 14, 31-35), servo application (col.6, lines 1-26), use of a rail (col. 31, lines 11-20).

Kuroyone does not disclose an analog proximity sensor, part reading while the part is in lower die or upper die section. The combination of Takahashi, Koseko and Narushima disclose an analog proximity sensor, same plane as the die (Takahashi col. 3-4, lines 59-2), part reading while the part is in lower die (Koseko col. 39, lines 3545, fig. 34), upper die section (Narushima (col.71-72, lines 64-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroyone to have the measurement device taught by Takahashi, Koseko and Narushima in order to do a highly accurate measurement (Koseko col. 1, lines 25-27, col. 5, lines 20-31) to reject or accept the part in order for the machine to be more efficient.

Response to Arguments

5. Applicant's arguments filed 6/10/2002 have been fully considered but they are not persuasive.

The applicant argue the Application No. 09/652236 does not use of rail and servo. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of

copending Application No. 09/652236. Claims 1-32 of co-pending application 09/652236 claims, for example only a press, measurement device and controller with rail. Application No. 09/652236 contain the similar subject matter except the use of servo and guide, both of the applications talk about power to the system and a physical guide of the object, this obviously encompasses overlaps the instant claims. This is a provisional obviousness-type double patenting rejection.

The applicant argue that Narushima does not disclose a rail nor servo for the rejection. While Narushima does not use the term rail, he does talk about using guide mechanism (col. 8, lines 41-63, col. 14-15, lines 14-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to know that Narushima would have suggested the rail to guide as an application. Narushima talk about use of servo (col. 61, lines 55-59).
Therefore with the above combination, Kuroyone would have taught 'wherein the forming rail is coupled to a servo and the press controller adjusts the servo based on the measurement from the sensor of the critical dimension of the part and further wherein the upper die includes a knocker that contact the forming rail to form the critical dimension of the part.'

As the claims 6-10 parallel claims 17-21 and 27-31, the applicant argue the prior art fail to measure signals during different portions of machine cycle. Kuroyone disclose a rotation controller controls rotation of the plane surface of the upper

metallic die, thereby **rotating and positioning** the plane surface at a position of the one angle of the **desired various angles** (see Abstract), Kuroyone would have suggested the reading of the measurement for rotation of the piece at a various angle, therefore Kuroyone would have suggested to measure signals during different portions of machine cycle.

The applicant also argue the prior art fail to teach the determination of average signal and compare to a threshold signal. While the usage of the average value and compare to a pre-determine value are common in the art to improve reliability of the data reading, as an example, Greiner (U.S. Patent 4,665,824) disclose the usage of such signal manipulation (col. 8, lines 5-14) and to increase the reliability of the system thereby reducing the press down time (col. 2, lines 6-15) in 1986.

The applicant also argue the prior art fail to teach the measurement of the signal between 130 and 150 degree and 180 and 360 degree, while Kuroyone does not disclose a particular angle reading, Kuroyone can bent in arbitary size and angle, the angle is accurate (col. 3, lines 15-26), therefore Kuroyone does teach his system able to measure of the signal angle included 130-150 and 180-360 degree.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung S Lau whose telephone number is 703-305-3309. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John S Hilten can be reached on 703-308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841 for regular communications and 703-308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JOHN S. HILTEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800